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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/824,811

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Yen-Fu Chen

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EXAMINER

BELANI, KISHIN G

ART UNIT

PAPER NUMBER

2143

MAIL DATE

DELIVERY MODE

09/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,811

Applicant(s)

CHEN ET AL.

Examiner

KISHIN G. BELANI

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to Applicant's RCE filed on 06/10/2008. All original **claims 1-35** have been cancelled. **A new independent claim 36 has been added.** **Independent claim 36** is now pending in the present application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/17/2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 36 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in paragraph 0042 of the specification, wherein it is disclosed that "The determination of whether a turn has occurred can be based on a pre-

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designated factor such as the amount of textual data entered **or** a time period".

However, the amended claim 36 discloses that "wherein a plurality of bases upon which the determining whether a turn has occurred comprise: an amount of textual data entered; a time period; **and** a plurality of successive statements".

The examiner will proceed with the prosecution based on the claim interpretation that only one of the three listed factors will be sufficient to reject the claimed element.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Briggs et al. (US Patent Publication # 7,080,139 B1)** in view of **Herf et al. (U.S. Patent Application Publication # 2005/0021624 A1)** and further in view of **Marston et al. (US Patent Application Publication # 2004/0260710 A1)** and further in view of **Bogard (U.S. Patent Publication # 6,757,365 B1)** and further in view of **St. John et al. (US Patent Application Publication # 2006/0004702 A1)** and further in view of **Solomon (US Patent Application Publication # 2005/0164154 A1)**.

Consider **claim 36**, Briggs et al. show and disclose a method for using topic tags in an Instant Messaging System (column 2, lines 26-41 which disclose an Instant Messaging System that collects a user's computer usage experience and shares that data among the user's buddies; Fig. 8D that shows a "Topic Sharing" tab and a list of topics 892 to select/deselect from by clicking in the checkboxes 891 or specifying the topic tags 893 entered by the user; column 8, lines 42-45 disclose the same details), comprising: identifying a topic (Fig. 8D, topics list 892, checkboxes 891 for identifying a

topic, "+ Add Topic Area" 893 for a custom topic; column 8, lines 42-45 disclose the same details) by performing a first plurality of steps comprising:

displaying a topic tag for a chat using an instant messaging service that allows a user to send and receive text messages in real time with an other user (Fig. 8D that shows a "Topic Sharing" tab and displays a list of topics 892 for a user to select/deselect from, by clicking in the checkboxes 891 or specifying the topic tags 893 entered by the user; column 8, lines 42-45 disclose the same details; column 4, lines 32-40 that describe an instant messaging service that allows a user to send and receive text messages in real time with another user in a chat session);

determining whether the user wants to accept the topic tag (Fig. 8D, displayed topics list 892, checkboxes 891 for identifying a topic selected by the user, "+ Add Topic Area" 893 for a custom topic; the Instant Messaging System capable of determining whether the user wants to accept the topic tag by checking the status of the checkboxes selected by the user);

responsive to determining that the user does not want to accept the topic tag, determining whether the user wants to distinguish the topic tag (Fig. 8D, displayed topics list 892, checkboxes 891 for identifying a topic selected by the user, "+ Add Topic Area" 893 for a custom topic; the Instant Messaging System, responsive to determining that the user does not want to accept the topic tag, determining whether the user wants to distinguish the topic tag by identifying any data in the "+ Add Topic Area" 893 for a custom topic);

responsive to determining that the user wants to distinguish the topic tag, entering a

term for the topic tag by the user (Fig. 8D, "+ Add Topic Area" 893 for a custom topic that enables the user to distinguish the topic tag and the Instant Messaging System to determine that the user has distinguished the topic tag; Fig. 9 that displays the user selected/entered topic in the message text, thereby disclosing entering a term for the topic tag by the user in the message text);

responsive to entering a term for the topic tag, determining whether the other user accepts the term for the topic tag (Fig. 8D which describes that each user will be able to turn the displayed topic areas on or off; column 8, lines 42-45 disclose the same details, thereby enabling the Instant Messaging System to determine whether the other user accepts the term for the topic tag); and

responsive the other user not accepting the term for the topic tag, using a default topic tag as the topic tag (column 8, lines 42-45 which further disclose that both default and particular user or user group administration is supported);

inserting the topic tag into the chat's text (Fig. 9, topic column 983 and message text column 984 that together show that the topic tag is inserted into the chat's text; column 9, lines 15-37 further describe the details of the columns shown in Fig. 9);

responsive to the user identifying a subtopic tag for the chat, inserting the subtopic tag into the chat's text (Fig. 8D, items 892 and 893; column 8, lines 42-45 which further disclose that topic or subtopic names 892 can be used; Fig. 9, topic column 983 and message text column 984 that together show that the topic/subtopic tag is inserted into the chat's text; column 9, lines 15-37 further describe the details of the columns shown in Fig. 9);

responsive to determining that a topic shift has occurred (disclosed by Herf et al. below), repeating the first plurality of steps (Fig. 9 that shows a plurality of topics, each as a single row of analogous details, indicating repeating the steps of the first topic described above, for other subsequent topics);

searching the repository (Fig. 3, Search entry window 371 and Search (Find) button 372 that are used to accept search criteria from the user and search the repository for the content of desired items; Fig. 9, messages tab 965 that provides access to a message repository; filters 971-973 are provided for a narrower focused search; column 6, lines 37-51 and column 8, lines 56-67 through column 9, lines 1-14 further disclose the same details) by performing a second plurality of steps comprising:

determining whether the search will be a full text search (Fig. 9, View activity window with a dropdown list of either "All Activity" or a select topic search and display; column 9, lines 8-9 that further disclose viewing of all or selected portions of a participant's activity by topic, thereby determining whether the search will be a full text search);

responsive to determining that the search will not be a full text search, determining whether the search will be a filtered search (Figs. 3 and 9, who filter 971, topic filter 972, and view filter 973, search term window 974, find button 975, and advanced find button 976 that together provide filtering and focused search capabilities; column 9, lines 4-14 disclose the same details, providing means for a filtered search);

responsive to determining that the search will be a filtered search, choosing a filter, wherein types of the filter comprise: a topic tag, a user name, and a date (Figs. 3 and 9, who filter 971, topic filter 972, and view filter 973, search term window 974, find

button 975, and advanced find button 976 that together provide filtering and focused search capabilities; column 9, lines 4-14 disclose the same details, providing means for a filtered search; Fig. 11; column 10, lines 54-56 which further disclose filter to select a range of dates; Fig. 9, column 988 shows the results of filtering by date);

conducting the search (Fig. 10 that shows a display of hit list after the filtered search has been done; column 9, lines 58-67 through column 10, lines 1-6 disclose the details of conducting the search);

determining whether the search was satisfactory (column 9, lines 30-35 which further disclose that in some instances, a user may need to access more detailed information about an activity in order to understand the topic involved, thereby disclosing determining whether the search was satisfactory);

responsive to determining that the search was not satisfactory, entering feedback by the user (Fig. 3, comments button 363 that when selected, activates a window for entering comments and feedback; column 6, lines 11-13 disclose the same details; Fig. 9, thumbs up/thumbs down 986 column, thoughts 987 column; column 9, lines 18-19 also describe the same details); and

responsive to determining that the user wants to view the full text of a found topic, displaying a segment of the transcript corresponding to the found topic (Figs. 9-10, columns 983-988 that display a segment of the transcript corresponding to the found topic, with next and previous buttons for scrolling the remaining data; column 9, lines 15-67 describe the same details);

responsive to determining that another search is to be conducted, repeating the second plurality of steps (Fig. 10, column 10, lines 1-6 which further disclose that when the (new) desired filters are selected, the submit button 1055 signals for the screen to be refreshed with the new information, indicating repeating the plurality of steps disclosed above).

However, Briggs et al. do not specifically disclose determining whether a turn has occurred; responsive to determining that a turn has occurred, determining whether a topic shift has occurred; saving a transcript of the chat to a repository in an XML format; scanning topic tags from the transcript by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table; responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; wherein the action comprises exporting the transcript to an e-mail; responsive to determining that there is another scanned topic tag, repeating the third plurality of steps; wherein a plurality of bases upon which the determining whether a turn has occurred comprise: an amount of textual data entered; a time period; **and or** a plurality of successive statements.

In the same field of endeavor, Herf et al. disclose determining whether a turn has occurred, and responsive to determining that a turn has occurred, determining whether a topic shift has occurred (paragraph 0026, lines 1-6 which disclose that a "snapshot" of the state of the system may be taken when each comment is made (to detect whether a turn has occurred), and if the snapshot has changed substantially since the previous

line in the conversation, the change is indicated with a thumbnail representing the change (determining whether a topic shift has occurred); paragraphs 0023, 0027, 0031, 0034, and 0054 further disclose the same details).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine whether a turn has occurred, and responsive to determining whether a turn has occurred, determine whether a topic shift has occurred, as taught by Herf et al., in the method of Briggs et al., so as to mark different topics of discussion in order to later identify and understand which topics were discussed during the session.

However, Briggs et al., as modified by Herf et al., do not specifically disclose saving a transcript of the chat to a repository in an XML format; scanning topic tags from the transcript by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table; responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; wherein the action comprises exporting the transcript to an e-mail; responsive to determining that there is another scanned topic tag, repeating the third plurality of steps; wherein a plurality of bases upon which the determining whether a turn has occurred comprise: an amount of textual data entered; a time period; **and or** a plurality of successive statements.

In the same field of endeavor, Marston et al. do disclose saving a transcript of the chat to a repository (Fig. 1, database module 114 that stores message contents 130; paragraph 0021, lines 1-5 disclose the same details).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to save a transcript of a chat to a repository, as taught by Marston et al., in the method of Briggs et al., as modified by Herf et al., so as to later display the selected contents of the message to the participating users.

However, Briggs et al., as modified by Herf et al. and Marston et al., do not specifically disclose that the transcript of the chat is saved in an XML format; scanning topic tags from the transcript by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table; responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; wherein the action comprises exporting the transcript to an e-mail; responsive to determining that there is another scanned topic tag, repeating the third plurality of steps; wherein a plurality of bases upon which the determining whether a turn has occurred comprise: an amount of textual data entered; a time period; **and or** a plurality of successive statements.

In the same field of endeavor, Bogard disclose saving the chat content in an XML format (Fig. 3, Instant Messaging Server 308, Voice Portal 310; column 12, lines 15-18 that disclose using XML to import their buddy list and textual data from the IM Server 308 using XML files; column 6, lines 32-44 further disclose using VoiceXML (VXML) for mobile devices); responsive to determining that there is another scanned topic tag (column 10, lines 19-38 which show an introductory conversation topic that turns to a registration topic when

the customer responds with a "No" to a question from the system), repeating the third plurality of steps (corresponding to determining that the user is not a registered user by checking a table of registered users (comparing the user's entered userid with the entries in the registration table), and after determining that the entered userid "User1" matches an entry in the registered users table, executing an action by informing the user to select a different userid and then sending a confirmation e-mail for registration of the user; these steps are further disclosed by St. John et al. below); wherein a plurality of bases upon which the determining whether a turn has occurred comprise: an amount of textual data entered; a time period; **and or** a plurality of successive statements (column 10, lines 19-38 which disclose that a plurality of bases upon which the determining whether a turn has occurred comprise a plurality of successive statements about the registration process).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to save the chat content in an XML format, and responsive to determining that there is another scanned topic tag, repeating the third plurality of steps, wherein a plurality of bases upon which the determining whether a turn has occurred comprise: an amount of textual data entered; a time period; **and or** a plurality of successive statements as taught by Bogard, in the method of Briggs et al., as modified by Herf et al. and Marston et al., because XML is a popular web-based mark up language, specifically suited for segmented content processing, and to alert the user about the change in the content topic.

However, Briggs et al., as modified by Herf et al., Marston et al., and Bogard, do not specifically disclose scanning topic tags from the transcript by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table; responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; wherein the action comprises exporting the transcript to an e-mail.

In the same field of endeavor, St. John et al. disclose scanning topic tags from the transcript (paragraph 0061 which discloses that information items and their associated gists are stored in the active database 14 (in Fig. 1), wherein each client 26 can query (scanning topic tags) the database to obtain information about the topics of interest to the client) by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table (Figs. 1 and 6; paragraphs 0061-0063 that disclose a method of handling auto alerts by the document server 8; further disclosing that the auto-alert contains at least the item identifier of the involved information item and the category of the terms that triggers the auto-alert); responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table (further disclosing in paragraph 0063 that the client manager searches the client profiles (auto-alert tables) to identify each client to whom the identified item is to be sent);

wherein the action comprises exporting the transcript to an e-mail (paragraph 0063 which states that in some cases, the auto-alert message may take the form of an e-mail containing the information item).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to scan topic tags from the transcript by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table; responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; wherein the action comprises exporting the transcript to an e-mail, as taught by St. John et al., in the method of Briggs et al., as modified by Herf et al., Marston et al. and Bogard, in order to deliver the information for the selected topic to each user who requested the information.

The claim feature "wherein a plurality of bases upon which the determining whether a turn has occurred comprise: a plurality of successive statements" is also disclosed by the cited Solomon reference in Fig. 27 where a topic turn is determined to have happened at Phase D (from topic 1 to topic 2), based on the plurality of successive statements at Phase D-F; paragraph 0124 discloses the same details.

Response to Arguments

Applicant's arguments with respect to **claim 36** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
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Hand-delivered responses should be brought to

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401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kishin G. Belani whose telephone number is (571) 270-1768. The Examiner can normally be reached on Monday-Friday from 6:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-0800.

/K. G. B./

Examiner, Art Unit 2143

August 29, 2008

/Tonia LM Dollinger/

Supervisory Patent Examiner, Art Unit 2143